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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,951	11/26/2003	Ladislav Bednarik	022829	9628

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EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/722,951

Applicant(s)

BEDNARIK ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10 and 12-17 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 11 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

(a) ethylene-vinyl acetate primer (claims 1, 3, 8, 17);

(B) epoxy modified polyolefin primer (claims 6, 18).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 2, 4-5, 7, 9-16, 19 generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Fletcher on 6/27/2005 a provisional election was made with traverse to prosecute the invention of species (a), claims 1, 3, 8, 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6, 18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over WIEST ET AL (US 4,044,197).

WIEST ET AL discloses an adhesive composition comprising ethylene-vinyl acetate functionalized with N-methylol acrylamide and catalyzable with acid catalysts (e.g., ammonium chloride).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the composition of WIEST ET AL to improve the adhesion of a cellulosic substrate.

6. Claims 2, 4, 5, 10, 12, 15-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over ADUR ET AL (US 4,942,295)

ADUR ET AL discloses a primed paperboard substrate, and an polyester coating, wherein the polyester has a coating weight as low as 4 lbs/ream.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional clay coated paperboard substrates (claims 4, 15) in the laminates of ADUR ET AL.

7. Claims 2-5, 9-10, 12, 15-17 is rejected under 35 U.S.C. 103(a) as being unpatentable over THOMPSON (US 4,455,184) in view of WIEST ET AL (US 4,044,197).

THOMPSON discloses a paperboard substrate, an adhesion promoting layer comprising ethylene vinyl acetate, and an polyethylene terephthalate coating, wherein the polyester has a

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coating weight as low as 5 lbs/ream, and a method of forming such coated paperboard, wherein the paper is flame treated prior to coating.

WIEST ET AL discloses that it is well known in the art to utilize ethylene-vinyl acetate functionalized with N-methylol acrylamide and catalyzable with acid catalysts (e.g., ammonium chloride) as a solvent-resistant adhesive.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a known EVA adhesive composition as disclosed in WEIST ET AL as an adhesion-promoting layer in THOMPSON in order to form solvent-resistant paperboard laminates. It also would have been obvious to utilize conventional clay coated paperboard substrates (claims 4, 15) in the laminates of THOMPSON in order to facilitate coating.

8. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over THOMPSON (US 4,455,184) in view of WIEST ET AL (US 4,044,197), as applied in claim 10, and further in view of HEETER ET AL (US 5,022,554).

HEETER ET AL discloses that it is well known in the art to mist polymer coated paperboard with water in order to improve shaping and forming into articles. (lines 40-61, col. 2; line 43-58, col. 5)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust the amount of water misted (claim 14) depending on the desired flexibility of the coated paperboard.

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***Allowable Subject Matter***

1. Claims 7, 8, 11, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

2. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fail to disclose polyester-coated paperboard substrates with the recited primer coating weights (claims 7-8, 11); or a method of forming polyester-coated paperboard substrates utilizing the recited line speed (claim 19).

***Conclusion***

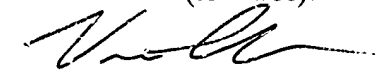
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 25, 2005



Vivian Chen  
Primary Examiner  
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